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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,824	05/22/2000	Yukinobu Ishino		2537

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EXAMINER	
TRAN, THAI Q	
ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/575,824	ISHINO ET AL.	
	Examiner	Art Unit	
	Thai Tran	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-8,10-19,25,26,28-30,35,37-64 and 66* is/are pending in the application.

4a) Of the above claim(s) *37-64* is/are withdrawn from consideration.

5)☒ Claim(s) *25,26 and 28-30* is/are allowed.

6)☒ Claim(s) *1-4,6-12,15-19,35 and 66* is/are rejected.

7)☒ Claim(s) *13 and 14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 May 2000 and 07 October 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/7/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed Oct. 7, 2004 have been fully considered but they are not persuasive.

In re page 16, applicants argue that Sakamoto does not disclose or suggest an image storage to be separately connected to a television set that includes a main memory, a digital circuit for retrieving still image data from the main memory, and input circuit and an output circuit, as recited in independent claims 1 and 3, or a television set that includes a tuner for receiving a broadcast program, a monitor, a mode selector for selecting between a first mode a second mode and a remote controller for controlling the television circuit in the first mode and in the second mode, as recited in independent claim 35.

In response, after careful consideration, the examiner respectfully disagrees. Sakamoto et al discloses in col. 8, lines 19-21 that

"Image data and audio data received from the digital still camera 100 through the PC card, the FD or the serial interface are compressed"

and in col. 12, lines 36-45 that

"In the process/edit menu screen as shown in FIG. 9C, when a processing has been selected by remote control operation (step S610), a menu screen of the corresponding processing is displayed, and this processing is carried out. In this case, it is assumed that "Image superimposing" is a processing item for superimposing an image of the digital camera 100 taken in from the external storage medium or through the serial interface with a predetermined stored image (here, a frame image)".

From the above passages, it is clear that the claimed "image storage to be separately connected to a television set that includes a main memory, a digital circuit for

retrieving still image data from the main memory, and input circuit and an output circuit" as recited in independent claims 1 and 3 is anticipated by the digital camera 100 of Sakamoto et al.

Sakamoto et al further discloses in col. 6, lines 25-38 that

"Referring to FIG.4, a digital image reproducing apparatus 10 is provided with a remote-control light receiver 122 for receiving signal light from the remote control unit 107 through the window 101. Remote controls signals produced by a user operating the remote control unit 107 are transferred to a processor (CPU) 120 through a remote-control light receiver 122. A tuner 126, which is a television signal receiver, is connected to an antenna input terminal 125. the tuner 1`26 outputs a video and audio signals included in the received television signal (here, NTSC signal) to an NTSC signal selector 132. The NTSC signal selector 132 inputs a video signal and an audio signal from external equipment through a video signal input terminal 127 and an audio signal input terminal 128, respectively",

in col. 7, lines 13-23 that

"A digital RGB signal outputted from the digital RGB signal processor 210 is converted to an analog RGB signal by an RGB signal processor 209, and the analog RGB signal from the RGB signal is output to the to the video signal selector 206. The video signal selector 206 selects one of the video signal from the NTSC signal processor 133 and the analog RGB signal from the RGB signal processor 209 and outputs a selected one to the display 129 such as CRT or LCE. The analog RGB signal from the RGB signal processor 209 is converted into a video signal by an RGB-NTSC converter 205, and the video signal is output to a video output terminal 204",

and in col. 8, lines 45-65 that

"If the displayed image on screen is not a desired one, the user operates the remote control unit 107 to select another image (step S312). Then, the CPU 120 decodes the image data of the selected file stored in the external storage medium to expand then on the RAM. And the expanded image data is transferred to the digital RGB signal processor 210 to be displayed on screen (step S313). If there exists an audio data file associated with the selected image data file, the CPU 120 transfers the audio data of the associated audio data file to the digital audio signal processor 211. the user can operate by remote control to make the desired image displayed on the display 129, and can make the associated audio sound generated from the speaker.

Although the user selects the desired file as described above, a plurality of images may be sequentially reproduced and displayed by the remote control unit until a user's desired image is displayed on screen. It may also be structured such that a predetermined numbered (for example, eight) of reduced images are displayed on

screen, and an image selected by the user operating the remote control unit 107 is displayed on full screen".

From the above passages, it is noted that the claimed "television set (**a digital image reproducing apparatus 10 of Sakamoto et al**) includes a tuner (**a tuner 126 of Sakamoto et al**) for receiving a broadcast program, a monitor (**the display 129 of Sakamoto et al**), a mode selector (**Although the user selects the desired file as described above, a plurality of images may be sequentially reproduced and displayed by the remote control unit until a user's desired image is displayed on screen. It may also be structured such that a predetermined numbered (for example, eight) of reduced images are displayed on screen, and an image selected by the user operating the remote control unit 107 is displayed on full screen of Sakamoto et al**) for selecting between a first mode a second mode and a remote controller (**remote control unit 107 of Sakamoto et al**) for controlling the television circuit in the first mode and in the second mode" as recited in independent claim 35 is met by the digital image reproducing apparatus 10 of Sakamoto et al.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 3-4, 6, 8, 10-11, 15-16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakamoto et al (6,687,453) as set forth the last Office Action.

Regarding claim 3, Sakamoto et al discloses a main memory for storing a plurality of digital still image data (col. 7, line 42 - col. 8, line 65); an input circuit for receiving a control signal from the television set (fig. 4, col. 6, line 25 - col. 8, line 65); and an output circuit for transmitting a still image signal on the basis of the digital still image data retrieved by the digital circuit (col. 8, lines 7-65).

Regarding claim 4, Sakamoto et al discloses that the output circuit includes an encoder for encoding the digital still image signal into the television signal which is transmitted to the television set (serial interface disclosed in col. 8, lines 56-65).

Regarding claim 6, Sakamoto et al discloses that that the image storage is further connectable to a printer, and wherein the output circuit is designed to transmit the still image signal to the printer (216, fig. 4).

Regarding claim 8, Sakamoto et al discloses that the digital circuit retrieves the desired one of the plurality of digital still image data in response to the control signal received by the input circuit (col. 8, lines 6-65).

Regarding claim 10, Sakamoto et al discloses that the integrated digital connector connectable to the television set, the input circuit and the output circuit being connected to the digital connector (105, fig. 4).

Regarding claim 11 , Sakamoto et al discloses that a control circuit for controlling the digital circuit and the output circuit in response to the input circuit which receives the control signal (fig. 4, lines 7-65).

Regarding claim 15, Sakamoto et al discloses a temporary memory for storing the digital still image data retrieved from the main memory, the output circuit transmitting the still image signal on the basis of the digital still image data stored in the temporary memory, wherein the digital circuit replaces the digital still image data in the temporary memory by a new digital still image data retrieved from the main memory in response to the input circuit which receives the control signal (col. 8, lines 7-65).

Regarding claim 16, Sakamoto et al discloses that the output circuit is capable of selectively transmitting a first type of still image signal including information of a single digital still image data and a second type of still image signal including information of a plurality of digital still image data, the output circuit being designed to select one of the first and second types of still image signal in response to the control signal received by the input circuit (col. 8, lines 20-65)

Regarding claim 18, Sakamoto et al discloses that the image storage is capable of being connected to a television set having a remote controller, and wherein the input circuit is designed to receive the control signal which is originated by the remote controller of the set (107, fig. 4).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Gleim et al (5,146,528) as set forth in the last Office Action.

Sakamoto et al discloses a system including an image storage placed separately from a television set (fig. 2) wherein the image storage comprises a main memory for storing a plurality of still image data (col. 1, lines 37-47); a digital circuit for retrieving desired one of the plurality of digital still image data from the main memory (not explicitly shown; however, a digital circuit for retrieving still images is inherent to digital cameras; an input circuit for receiving a control signal from the television set (fig. 2); and a first output circuit for transmitting a still image signal to the television set on the basis of the digital still image data retrieved by the digital circuit (fig. 2); and the television set comprises a television circuit including a tuner for retrieving a broadcast program (fig. 4, lines, 126); a monitor for selectively displaying one of the broadcast programs from the television circuit and the still image on the basis of the still image signal transmitted from the image storage by the output circuit (129); and a second output circuit (col. 8, lines 45-65). However, Sakamoto et al does not disclose a second output circuit for transmitting the control signal to the input circuit of the image storage.

Gleim et al teaches a cable that allows the transmission of control signals between devices (whole document). Further, Sakamoto et al discloses retrieving images from the digital camera (col. 8, lines 20-65). Therefore, it would have been obvious to have an output circuit for transmitting the control signal to the input circuit of the image storage (i.e. appears that some type of control signal should be sent to the

digital camera to retrieve the still images).

It would have been highly desirable to have an output circuit transmitting the control signal so that the still images can be retrieved from the digital camera.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an output circuit transmitting the control signal to the image storage device in the device of Sakamoto et al.

Regarding claim 2, Sakamoto et al discloses that the television set further comprising a remote controller, and wherein the second output circuit is designed to transmit the control signal in response to the remote controller (107, col. 8, lines 45-65).

Regarding claim 66, Sakamoto et al discloses that the first output circuit includes an encoder for encoding the digital still image signal into the television signal (serial interface disclosed in col. 8, lines 56-65).

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Yoshimura et al (5,585,934) as set forth in the last Office Action.

Regarding claim 7, Sakamoto et al does not disclose that the image storage is further connectable to a modulator-demodulator for data communication, and wherein the output circuit is designed to transmit the still image signal to the modulator-demodulator.

Yoshimura et al teaches that the image storage is connectable to a modulator-demodulator for data communication and wherein the output circuit is designed to transmit the still image signal to the modulator-demodulator (col. 1, line 20 - col. 2, line 31).

It would have been highly desirable to have connectable modulator-demodulator so that the still image data can be reproduced on a TV monitor or the like.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a connectable modulator-demodulator in the device of Sakamoto et al.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Rilly (6,085,017) as set forth in the last Office Action.

Regarding claim 12, Sakamoto et al does not disclose that the main memory has a rested condition and an active condition both with a main power supplied, wherein the main memory is changed between the rested condition and the active condition in response to the input circuit which receives the control signal.

Rilly teaches a device that has a rested condition that is changed to an active condition in response to a received control signal (col. 1, lines 29-60).

It would have been highly desirable to have a rested condition so that the power consumption of the device is low.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a rested condition in the device of Sakamoto et al.

8. Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Escallon (5,799,157) as set forth in the last Office Action.

Regarding claim 17, Sakamoto et al does not disclose that the output circuit is designed to replace the second type of still image signal by the first type of still image signal in response to the control signal received by the input circuit with the second type

of image signal transmitted for a selection among the plurality of digital still image data included therein.

Escallon teaches that the output circuit is designed to replace the second type of still image signal by the first type of still image signal in response to the control signal received by the input circuit with the second type of image signal transmitted for a selection among the plurality of digital still image data included therein (col. 3, line 61 - col. 4, line 9).

It would have been highly desirable to have the mode changed during a slide show when a user selects an image of interest so that a user can view an image of interest without having to input a mode switching command.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to change from a second type of still image to a first type in response to a control signal in the device of Sakamoto et al.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Jung (5,109,284) as set forth in the last Office Action.

Regarding claim 19, Sakamoto et al discloses a main switch (101). However, Sakamoto et al does not discloses turning the image storage on or off in response to the control signal.

Jung teaches turning on or off an external device in response to the control signal (col. 2, lines 30-67). It would have been obvious to turn the image storage on or off in response to a control signal.

It would have been highly desirable to have the image storage turned on or off in

response to a control signal so that the connected devices are turned on and off together with a single command (col.2, line 64 - col. 3, line 5).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to turn on and off the image storage in the device of Sakamoto et al.

10. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al in view of Torres et al (6,738,075).

Regarding claim 35, Sakamoto et al discloses a television circuit including a tuner for receiving a broadcast program (fig. 4); a monitor for selectively displaying a single image and a set of a plurality of divided images (col. 8, lines 20-65); a mode selector for selecting between a first mode for the monitor to display the single image and a second mode of the monitor to display the set of images (col. 8, lines 20-65); and a remote controller for controlling the television circuit in the first mode and for selecting one of the plurality of divided images in the second mode (col. 8, lines 45-65); that the remote controller includes a set of a plurality of manually operable members to be commonly used in the first and second modes (col. 8, lines 20-65). However, Sakamoto et al does not disclose that the set of a plurality of images are arranged in a similar pattern to that of the manually operable members.

Torres et al teaches a pattern of image display including a set of nine images (fig. 4A). Further, it is commonly known that remote controller often have numerical buttons 1-9 arrange it a similar pattern (specifically in the order from 1 to 9) as the image set.

It would have been highly desirable to have image pattern shown in Torres et al

so that easy selection of an image is facilitated with the remote controller.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have the image pattern in the device of Sakamoto et al.

Allowable Subject Matter

11. Claims 25-26 and 28-30 are allowed.

12. Claims 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ